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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,471	07/24/2001	Theodore M. Wong	SP-1093.3	6281

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EXAMINER

WARE, DEBORAH K 10

ART UNIT

PAPER NUMBER

1651

DATE MAILED: 02/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/912,471

Applicant(s)
Wong et al.

Examiner
Deborah Ware

Art Unit
1651



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov 1, 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-80 is/are pending in the application.
- 4a) Of the above, claim(s) 37-80 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6 6) ☐ Other:

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Claims 1 and 3-80 are pending.

The IDS and Preliminary Amendment filed July 24, 2001, have been received and entered. Claims 92-93, 95-101 and 106-113 were not entered because they are considered to be out of numerical sequence for the instant case because the case was filed with original claims 1-80. Cancellation of claim 2 was entered, however, claims 94 and 103-105 are not considered to be in the instant case and thus, can not be canceled. It is suggested that Applicants present properly numbered corresponding claims which they want to add to the instant case which occur after claim 80 with the next highest numbered claim which would be claim 81, etc. If Applicants need further assistance with this matter please phone the examiner to resolve this issue, note the phone number at the end of the office action.

1. Applicant's election with traverse of Group I, claims 1 and 3-36 in Paper No. 9 is acknowledged. The traversal is on the ground(s) that Applicants believe additional claims are in this case, however, for the reasons set forth above this is not correct. Therefore, the traversal of the restriction requirement is not found persuasive. The restriction may be reconsidered and is not being made final at this time. Claims 37-80 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention(s), there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 9.

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2. The instant case is a CIP of 08/996,976 which is now abandoned and Applicants are requested to update the status of this parent file at page 1, line 1, of the instantly filed case.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1 and 3-36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of copending Application No. 09/912,494. Although the conflicting claims are not identical, they are not

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patentably distinct from each other because the claims only differ with respect to the scope of their claimed subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The instant claims are drawn to a method for producing a soy protein material.

The copending claims are drawn to a method for producing a purified vegetable protein material. Both sets of claims require the same process steps: forming a slurry, treating the slurry and washing the treated slurry. Furthermore, a soy protein is encompassed by a vegetable protein material. Thus, the claims of the instant case would have been made obvious by the claims of the copending case and thus, one of skill would have been motivated to select for soy in the method of the copending claims. Any variations in the process steps for obtaining purity of the protein material by weight is clearly an obvious modification. The claims are prima facie obvious over the copending claims.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior

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art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1 and 3-36 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 0 380 343, cited on the enclosed PTO-1449 Form.

Claims are drawn to a method for producing a soy protein material comprising forming a slurry, treating the slurry with preparation containing acid phosphatase and washing the soy protein.

EP Patent teaches a method for producing a soy protein material comprising forming a slurry, treating the slurry with preparation containing acid phosphatase and washing the soy protein. Note the abstract, page 2, lines 1-5, page 4, lines 1-32, page 6, lines 15-30, and pages 7-9, all lines.

The claims appear to be identical to the disclosure of the EP Patent and are therefore, considered to be anticipated by the teachings of the cited reference. However, in the alternative

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that there is some difference between the claims and the cited reference then such difference is considered to be so slight as to render the claims prima facie obvious over the cited reference. The arguments presented by the Preliminary Amendment are noted. In particular that an enzyme preparation containing an acid phosphatase enzyme is not disclosed by the EP Patent is noted, however, it is believed by the examiner that the FINASE disclosed does contain acid phosphatase and that this is well known in the art. Therefore, the argument that the EP Patent is not limited to use of an enzyme preparation containing an acid phosphatase is not deemed persuasive. Further, in view of the teaching of FINASE in the cited EP reference it is apparent that the preparation may indeed include an acid phosphatase. Applicants analysis of the Mehl/Biophile International Corp. is noted too, but in view of the teaching of FINASE it is a case which is not persuasive to overcome this rejection over the EP Patent. Furthermore, it is a hair material and not a vegetable material as set forth and claimed herein. Thus, Applicants' argument are not deemed persuasive and the cited reference appears to be a good reference against the claimed subject matter.

All claims fail to be patentably distinguishable over the state of the art discussed above and cited on the enclosed PTO-892 and/or PTO-1449. Therefore, the claims are properly rejected.

The remaining references listed on the enclosed PTO-892 and/or PTO-1449 are cited to further show the state of the art.


No claims are allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah K. Ware whose telephone number is (703) 308-4245. The examiner can normally be reached on Mondays to Fridays from 9:30AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn, can be reached on (703) 308-4743. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


DEBORAH K. WARE
PATENT EXAMINER

Deborah K. Ware

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January 24, 2003